

Applicant : Herbert Howell Waddell
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Pursuant to 37 C.F.R. § 1.193(a)(1), Applicant contests that the January 9, 2003 Office Action fails to satisfy the statutory requirement of a written statement by the primary examiner in answer to the Appeal Brief. If the above-identified Office Action is a result of the decision by the primary examiner to reopen prosecution after an appeal brief has been filed, Applicant further contests that this decision has not been clearly communicated.

Without conceding to the validity of the Office Action in lieu of an Examiner's Answer to the Appeal Brief, Applicant hereby submits this Response under protest to avoid abandonment of the application pursuant to 37 C.F.R. § 1.193(b)(2).

The deadline for filing this Response is THREE (3) months from the January 9, 2003 mailing date of the Office Action. Accordingly, this Response is timely filed.

No fee is deemed necessary in connection with the filing of this Response. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 50-1891.

Rejection of Claims under 35 U.S.C. § 103(a)

Claims 1-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jones (6,120,073) in view of Davis (318,359). The basis for all obviousness rejections is set forth under 35 U.S.C. § 103(a) that provides:

A patent may not be obtained though the invention is not identically disclosed or described as set forth

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in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Applicant respectfully traverses and submits that this rejection is in error. As detailed below, all prior art for devices of the nature of the subject invention shows the use of couplings that are useful only in a single configuration that restricts the motion of the coupled elements and it would not be obvious from Davis '359, in view of Decker '645, to use a flexible coupling between the grasping elements which could be moved to provide functional pivot points anywhere along the length of the shafts and would also permit rotation of the elements along the axes of their shafts to change their operational configuration.

Davis '359 teaches that two similar shovels can be connected with a moveable coupling means (sliding clamp) to form an improved post-hole digger. The two shovels have shafts with square cross sections above the spade heads, but have circular cross sections at the upper ends. The square cross section of shaft A' bears on the "square" end of the clamp C (lines 41-43 and Figure 4) and the square cross section of shaft A bears on the straight, cylindrical rod that forms a fulcrum at the other end of the clamp (lines 42 -47 and Figure 4). A strong, rigid iron clamp is used to withstand the force on the fulcrum when the long handles are pulled outward to draw the shovels together in use. The flat sides of the square shafts bearing on straight surfaces of the clamp provide maximum bearing

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surface and prevent rotation of the shafts along their axes during operation of the device. Rotation of the shafts is undesirable, and the square shafts are designed to prevent it. Shaft A has a short horizontal section immediately above its spade head (B) to support the clamp at its operating position slightly above the spade heads (B and B'). The purpose of the circular cross sections is not stated in the specification or addressed in the claims, so does not appear to be material to the function of the invention. The purpose could be simply to make the handles more comfortable to hold or to facilitate the removal of the sliding clamp to permit the shovels to be used separately. The device will not perform as a post-hole digger unless the parts are as in Figures 2 and 3. The sliding clamp can be removed or shovel AB can be raised out of its operating position to permit shovel A'B' to be used separately and thrust into the ground. However, if the clamp is moved along one or both shafts so that clamp C does not connect them as shown in the figures, the device will not perform its function as a post-hole digger, the two shovels will not function together in any way, and no description or claims to that effect appear in the patent. Likewise, if the clamp is raised and either or both shovels are rotated out of the position shown in the figures the device will not perform its function as a post-hole digger, or any other useful function, and no description or claims to that effect appear in the patent. Davis clearly teaches that the clamp must be in one specific position for the two shovels to function as a post-hole digger, that the clamp must be rigid and strong and that the two shovels will not serve a useful purpose if they are rotated so that they are not directly opposed.

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Decker '645 discloses that two handles can be attached to a snow shovel with a hinge in such a way that a "swing shovel" is formed that requires less stooping and lifting by the operator. The end of one handle is connected by a hinge of elastomeric material to the shaft of the other handle. Movement of the hinge along the shaft or rotation of the handles is undesirable, so the hinge is fixed (in the words of the inventor) to the handles with adhesives or other means. The hinge is designed (Figures 24, 24a, 24b, 24c, and 24d) to permit only minimal side to side relative motion of the two handles about the pivot point, that is, to act as a hinge and not as a completely flexible coupling (Column 1, lines 32-40). There is no explanation of why a simple metal hinge could not perform as well as a flexible hinge. The device of Decker '645 bears no resemblance to the device claimed by the applicant in that the Decker device has only one functional head, a shovel. Lacking the two functional grasping heads in the applicant's device it cannot perform the same functions, namely gathering, grasping and lifting loose objects such as leaves. Furthermore, the flexible coupling is fixed in place, so cannot be moved along the shafts and the shafts can not be rotated along their axes.

The examiner stated in the January 9, 2003 Office Action that "It would have been obvious to one having ordinary skill in the art to provide the apparatus of Davis with the teachings of Decker in order to provide a material gathering apparatus with a greater operational range." If the apparatus of Davis '359 is provided with the teachings of Decker '645, one would have a post hole digger with a fixed, flexible coupling just above the shovel heads. Such a fixed, flexible coupling would prevent separate use of the shovels and would prevent lifting

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shovel AB up so that A'B' could be thrust into the ground separately. It would also permit the shovels to rotate side to side somewhat, which Davis took steps to prevent by using square shafts in a rigid, albeit moveable, coupling, which he called a sliding clamp. This clamp is designed to minimize twisting and side to side movement of the shafts. Its design teaches away from the use of a flexible coupling, so it would not be obvious to one skilled in the art of post-hole diggers to use a flexible coupling.

The snow shovel of Decker '645 is a single-headed device, not a grasping device, so one of ordinary skill in the art of grasping devices would not look at Decker for ways to improve grasping devices. When the Examiner relies on inventions other than that claimed in a patent application in showing that "some objective teaching" in the prior art would have suggested the claimed subject matter to a person of ordinary skill in the art, the Examiner is required to designate the particular part relied on as nearly as practical. 37 C.F.R. § 1.104(c) (2) provides in pertinent parts:

In rejecting claims for . . . obviousness, the examiner must cite the best references at his or her command. When a reference . . . shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (emphasis added)

Absent some teaching or suggestions supporting the combination, obviousness 'cannot be established by combining the teachings of the prior art to produce the claimed invention.' In re Bell, 991 F.2d at 784 (quoting In re Burckel, 592 F.2d 1175,

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1179, 201 USPQ 67, 70 (CCPA 1979). While 'a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests,' the Examiner must show the requisite teaching or suggestion to combine the teachings of the cited prior art reference. Id. at 785.

In the nearly one hundred and eighteen years since Davis '359 was granted a great number of inventors have disclosed grasping devices employing coupled opposed shovels or rakes, and in the fourteen years since Decker '645 was granted more have made similar disclosures. This clearly indicates that there has been a long time recognized need for improved grasping devices. Yet none of the shown or claimed couplings for grasping devices were flexible or movable to change the operating configuration of the parts. Whether alone or in combination, therefore, they provide no teaching, suggestion or motivation for the claimed apparatus. In fact, they teach away from it by showing that fixed couplings are required to make their devices serve their intended purpose. In view of all of these other inventions, it was unexpected and non-obvious that a flexible, moveable coupling would have utility.

The very long time that the devices to gather, pick up and carry loose materials have been known and improved by scores of inventions argues that no one has thought of the applicant's invention in all that time and that it was not obvious to those skilled in the art. The Supreme Court has long established the principle that such secondary considerations as "long felt but unsolved needs [and] failure of others" may be relevant as indicia of obviousness or nonobviousness. Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966). "Thus evidence rising out of the so-called 'secondary

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considerations' must always when present be considered en route to a determination of obviousness." Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538, 218 USPQ 871, 876 (Fed. Cir. 1983) (quoting In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983)). Evidence of secondary considerations may often be the most probative and cogent evidence in the record and all pieces of evidence should be fully considered and each should be given appropriate weight. Id. 1538-1539. Therefore, Applicant respectfully submits that the Examiner consider that no one has thought of the claimed invention despite the fact that the devices to gather, pick up and carry loose materials have long been known and improved by scores of inventions.

The Examiner also made reference to Jones '073, but that patent was not issued until after the subject application was filed as a provisional patent, so is not relevant to any discussion of obviousness at the time that the invention was made.

Conclusion

For the above reasons, Applicant respectfully requests that the above remarks be entered and made of record in the present application. An allowance is earnestly requested.

If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicant's undersigned attorney invites the Examiner to telephone at the number provided below.

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Respectfully submitted,

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